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G. VICTOR TREYZ FLOOD BUILDING 870 MARKET STREET, SUITE 984 SAN FRANCISCO, CA 94102			NGUYEN, CUONG H	
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BEFORE THE BOARD OF PATENT APPEALS AND
INTERFERENCES

Paper No. 16

Application Number: 09/365,651

Filing date: 08/02/1999

Appellants: G. Victor Treyz et al.

G. Victor Treyz
For Appellants

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GROUP 3600

EXAMINER'S ANSWER

This is in response to appellants' brief on appeal filed on March 15, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

There is none related appeal and interference which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection

contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Group I: Claims 21-26 and 28-30. Dependent claims 22-26, and 28-30 stand or fall with independent claim 21.

Group II: Claim 27.

Group III: Claim 31.

Group IV: Claim 32.

Group V: Claims 33, 35-37, and 40.

Group VI: Claims 34 and 39.

Group VII: Claim 38.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Oberg (US Pat. 5,870,771);

Melissa A. Weiseman's 'Internet wedding albums reach far-flung relatives'

Nozaki et al., (US Pat. 6,349,194);

Plettinck et al., (US Pat. 5,689,349);

Bruck et al., (US Pat. 6,008,836).

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. The ground(s) for rejection (for pending claims 21-40) are reproduced below from the final Office Action and are provided here for the convenience of both Appellants and the Board of Patent Appeals:

A. Re. to claims 21, 23-30: They are rejected under 35 U.S.C. 103(a) as being unpatentable over **Oberg** (US PAT. 5,870,771), in view of **Nozaki et al.**, (US Pat. 6,349,194).

Oberg teaches an equipment that allows a user to order image-based products over the Internet, comprising:

- An order servicing computer that receives an uploaded digital image over the Internet; and digital printing equipment, wherein the order opportunity to view the uploaded digital image on-line over the Internet, wherein the order servicing computer is configured to provide the user with an opportunity to edit the uploaded digital image on-line over the Internet, wherein the digital printing

equipment is configured to print the edited digital image to create a print for framing, (see **Oberg**, 3:34-53, Oberg's system is capable of creating a composite visual concept of a customer's order and allows the customer to adjust the color, size, width and other characteristics of frames and matting materials until the desired combination is achieved. "

And in 7:34-51 Oberg teaches a user selects the frame and review for satisfaction when matching to a print.

Oberg does not expressly disclose that "an order servicing computer is configured to present the user with an opportunity to select a given type of frame for the print".

However, Nozaki et al. suggest that "a customer can change the sizes and positions of the image frame ... the customer desires to add frames, new frames of selected sizes ... or a selected image frame (see Nozaki et al., 13:37-47).

It would be obvious for one with ordinary skill in the art to implement Oberg 's ideas with Nozaki et al. 's suggestion to select a frame for a picture, since a framed picture could be placed in many places and increasing good values to the picture; all above cited references were in the same specific application of digital images for picture-ordering online, further more components in this "system" claim must be distinguished from cited prior art in terms of structure(s) rather than functions.

B. Re. to claim 23: The rationales and references for rejection of claim 21 are incorporated.

Oberg also teaches that a servicing computer is configured to crop an uploaded image on-line (see Oberg, the abstract).

C. Re. to claim 24: The rationales and references for rejection of claim 23 are incorporated.

Oberg also discloses that an order computer is configured to set up an account by providing a name, e-mail address (see Oberg, 2:47-67 especially "...present images of frame moldings and colored accent matting that coordinate with the artwork."

And in 3:54-64 Oberg's system is capable of generating a bill of material or order template that lists the customer's name, address, and phone number, the products or component materials selected, ... Oberg's system may calculate these figures at the user's request." (this shows that Oberg suggests of setting up an account), Oberg also suggests that a password is used and is configured to provide text associated with an image using Internet (see Oberg, 4:1-9, 7:14-33).

D. Re. to claim 25: The rationales and references for rejection of claim 23 are incorporated.

Oberg also teaches that a servicing computer is configured to change image to different colors (see Oberg, the Abstract, 1:20-47, 2:12-67, 3:7-16, 3:24-66, 4:32 to 5:47, 5:60 to 6:35, note that Oberg 6:63-67, discloses "allows the customer to adjust sizes and colors of the frame and matting material once they are combined with the input image for viewing").

E. Re. to claim 27: The rationales and references for rejection of claim 21 are incorporated.

Oberg's computer is configured for a user to order frames of different colors and is configured to provide the user with an on-line opportunity to order albums of different materials.(see Oberg, the Abstract, 3:7-11, 3:25-53).

F. Re. to claim 28: The rationales and references for rejection of claim 21 are incorporated.

Oberg teaches that the order servicing equipment defined in claim 21 wherein the order servicing computer is configured to allow the user to add audio to uploaded digital image(s) over the Internet. (see Oberg, 4:32-57).

G. Re. to claims 29-30: The rationales and references for rejection of claim 21 are incorporated.

Oberg teaches that the order servicing equipment is configured to provide the user with an on-line opportunity to select from different mat styles for corresponding selected frames (see Oberg, the abstract), and make orders (see Oberg, Fig. 2C).

H. Claims 31-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberg (US PAT. 5,870,771), in view of Nozaki et al., (US Pat. 6,349,194), and further in view of Melissa A. Weisman's article.

a. Re. to claim 31: Oberg (3:54-60) does not disclose that his computer is configured to email a message to a party other than the user over the Internet, wherein the message includes a URL that allows the party to view and order prints.

However, Weisman's article teaches this limitation ("forwarding" a message in the Internet - see Weisman, page 1).

b. Re. to claims 32, 34:

Weisman also teaches that the order servicing computer is configured to provide the user with an opportunity to order a print of a digital image that includes the user as a subject (see Weisman's article, it was suggested as ordering a picture of "a wedding guest"), and that includes a background different than the background against which the user was originally photographed (see Weisman, page 2).

It would be obvious to one of ordinary skill in the art to combine Oberg, Nozaki, and Weisman because artisans recognize that an identity for a person, a location (e.g., a URL) or a different background are necessary to specify in any ordering communication because this is very convenient in communications to different parties.

c. Re. To claim 33: This "system" claim contains similar features as in system claims 21, 24, and 32. Therefore, similar rationales and references set forth for rejections of claims 21, 24, and 32 are combined for a rejection of claim 33 under 35 U.S.C. § 103(a) on cited art of Oberg, and Weisman, and Nozaki et al.

d. Re. To claim 35: This "system" claim contains similar features as in a system claims 21 and 33. Therefore, similar rationales and references set forth for rejections of claims 21, and 33 are combined for a rejection of claim 35 under 35 U.S.C. § 103(a) on cited art of Oberg, Weisman, and Nozaki et al.

e. Re. To claim 36: This "system" claim contains similar features as in a "system" claims 23, and 33. Therefore, similar rationales and references set forth for rejections of claims 23 and 33 are combined for a rejection of claim 36 under 35 U.S.C. § 103(a) using Oberg, Weisman, and Nozaki et al.

f. Re. To claim 37: This "system" claim contains similar features as in "system" claims 21, 25-26, and 32. Therefore, similar rationales and references set forth are applied for a rejection under 35 U.S.C. § 103(a) using Oberg, Weisman, and Nozaki et al.

g. Re. To claim 38: This "system" claim contains analogous features as in a system claim 21. The generic acts of viewing/ordering different frames for digital images are obvious to this computerized-application business. Therefore, similar rationales and references set forth for a rejection of claim 21 are applied for a rejection of claim 38 under 35 U.S.C. § 103(a) using Oberg, and Nozaki et al.

h. Re. To claim 39: This "system" claim contains analogous features as in system claims 32 and 38. Therefore, similar rationales and references set forth for rejections of claims 32 and 38 are combined for a rejection of claim 39 under 35 U.S.C. § 103(a) using Oberg, Weisman, and Nozaki et al.

i. Re. To claim 40: This "system" claim contains similar features as in a system claim 21 and 38 because of Internet capability in communications is a fact. One of ordinary skill in the art would recognize that Internet is used to communicate anywhere in the globe. Therefore, similar rationales and references set forth are applied for a rejection under 35 U.S.C. § 103(a) using Oberg, and Nozaki et al.

I. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oberg (US PAT. 5,870,771), in view of Nozaki et al., (US Pat. 6,349,194), and in view of Plettinck et al., (US Pat. 5,689,349).

The rationales and references for rejection of claim 21 are incorporated.

Oberg and Weisman do not disclose that an order equipment comprises packaging equipment.

However, Plettinck et al., suggest that idea in Brief Summary Text portion (para.5):

"The method of the present invention is capable of many applications for printing color prints, such as packaging or pictures in periodicals or books.").

It would be obvious for one with ordinary skill in the art to implement Oberg 's ideas with Nozaki et al. 's, and Plettinck 's suggestion to include a packaging equipment in the claimed system for mailing finished products to customers according to ordering items.

J. Re. to claim 26: It is rejected under 35 U.S.C. 103(a) as being unpatentable over Oberg (US PAT. 5,870,771), in view of Nozaki et al., (US Pat. 6,349,194), further in view of Bruck et al.(US Pat. 6,008,836).

The rationales and references for rejection of claim 25 are incorporated.

Oberg suggests a computer is configured to change image color/contrast. Furthermore, Bruck et al. clearly define a selection of image's contrast (see Bruck et al., claims 3, 8, 21 and "The user selects the contrast setting in accordance with the optimum contrast of the test pattern. After the user sets the

contrast of the display to the proper position, he selects the continue anchor 83 to invoke the next picture adjustment screen").

It would be obvious for one with ordinary skill in the art to implement Oberg 's ideas with Nozaki et al., and Bruck et al. 's suggestion to select a frame for a picture, since Bruck et al. suggest in a digital world, a contrast could be changed in order to give a selected picture.

(11) Conclusion

Claims 21- 40 are not patentable.

(12) Response to Argument:

At first, pending claims difference compared to cited prior art are only found in the non-functional data stored on the article of manufacture. Data identifying a name of a customer, or an image of a customer, or a list of customer's name are not functionally related to the claimed equipment because these descriptive materials will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gullack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

a. Group I: Claim 21 is a broadest claim; therefore it is analyzed herein.

It is rejected under 35 U.S.C. 103(a) as being unpatentable over Oberg (US PAT. 5,870,771), in view of Nozaki et al., (US Pat. 6,349,194).

The combinations of Oberg and Nozaki et al. teach an equipment that allows a user to order image-based products over the Internet, comprising:

- An order servicing computer that receives a digital image over the Internet (see Nozaki, the abstract and Fig.1); and digital printing equipment, wherein the order opportunity to view the digital image over the Internet (see Oberg, claim 1), wherein the order servicing computer is configured to provide the user with an opportunity to edit the digital image over the Internet (see Nozaki, Fig.1 ref.12, and claim 7), wherein the digital printing equipment is configured to print the edited digital image to create a print for framing, (see Oberg, 3:34-53, Oberg's system is capable of creating a composite visual concept of a customer's order and allows the customer to adjust the color, size, width and other characteristics of frames and matting materials until the desired combination is achieved).

And in 7:34-51 Oberg teaches a user selects the frame and review for satisfaction when matching to a print.

Oberg does not expressly disclose that "an order servicing computer is configured to present the user with an opportunity to select a given type of frame for the print".

However, Nozaki et al. suggest that "a customer can change the sizes and positions of the image frame ... the customer desires to add frames, new frames of selected sizes ... or a selected image frame (see Nozaki et al., 13:37-47).

It would be obvious for one with ordinary skill in the art to implement Oberg 's ideas with Nozaki et al. 's suggestion to select a frame for a picture, since a framed picture could be placed in many places and increasing good

values to the picture; all above cited references were in the same specific application of digital images for picture-ordering online, further more components in this "system" claim must be distinguished from cited prior art in terms of structure(s) rather than functions.

b. Group II: Claim 27 (this claim is a dependent to claim 21).

The rationales and references for rejection of claim 21 are incorporated.

Oberg's computer is configured for a user to order frames of different colors and is configured to provide the user with an on-line opportunity to order albums of different materials (see Oberg, the Abstract, 3:7-11, 3:25-53).

It would be obvious for one with ordinary skill in the art to implement Oberg's ideas with Nozaki et al.'s suggestion to order frames of different colors and to order albums of different materials because they operate online prints-order businesses.

c. **Group III:** Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oberg (US PAT. 5,870,771), in view of Nozaki et al., (US Pat. 6,349,194), and further in view of Melissa A. Weisman's article.

This claim is dependent to claim 21; therefore, the rationales and references for rejection of claim 21 are incorporated.

Nozaki et al., and Oberg (3:54-60) do not expressly disclose that their computers are configured to email a message to a party other than the user over the Internet, wherein the message includes a URL that allows the party to view and order prints.

However, Weisman's article teaches this limitation by "forwarding" a message in the Internet – (see Weisman, page 1).

It would be obvious to one of ordinary skill in the art to combine Oberg, Nozaki, and Weisman because artisans recognize that informing about a location (i.e., a URL) is necessary to ordering/viewing of related parties, particularly for picture prints.

d. Group IV: Claim 32 is dependent to claim 21; therefore, the rationales and references for rejection of claim 21 are incorporated.

Weisman also teaches that the order servicing computer is configured to provide the user with an opportunity to order a print of a digital image that includes the user as a subject (see Weisman's article, it was suggested as ordering a picture of "a wedding guest"), and that includes a background different than the background against which the user was originally photographed (see Weisman, page 2).

One of ordinary skill in the art would combine Oberg, Nozaki, and Weisman because artisans recognize that an identity for a person, a location (e.g., a URL), a different background have been necessary to specify in ordering because this is very convenient and easy to do with a popular trend of computerized communications between different parties.

e. Group V: Claims 33, 35-37, and 40; claim 40 is analyzed herein. This claim is dependent to claim 38; therefore, the rationales and references for rejection of claim 38 are incorporated.

This "system" claim contains similar features as in a system claim 21 and

38 because of Internet capability in communications is a fact, where sending, receiving, and printing computers can be in different cities.

One of ordinary skill in the art would recognize that Internet is used to communicate anywhere in the globe. Therefore, a combination of Oberg, and Nozaki et al. to order prints on the Internet would be obvious to claim 40 subject matter.

f. Group VI: Claims 34 and 39.

Re. to claim 34: It is rejected under 35 U.S.C. 103(a) as being unpatentable over Oberg (US PAT. 5,870,771), in view of Nozaki et al., (US Pat. 6,349,194), and further in view of Melissa A. Weisman's article.

Weisman also teaches that the order servicing computer is configured to provide the user with an opportunity to order a print of a digital image that includes the user as a subject (see Weisman's article, it was suggested as ordering a picture of "a wedding guest"), and that includes a background different than the background against which the user was originally photographed (see Weisman, page 2).

One of ordinary skill in the art would combine Oberg, Nozaki, and Weisman to suggest that "...a customers was originally photographed against a solid color background to produce a digital image and wherein that digital image was manipulated to replace the solid color background with a new background, and wherein a print of the digital image that includes the customer with the new background is provided for on-line ordering by the customer over the Internet...", because artisans recognize Weisman teaches a similar system that an identity

for a person, a location (e.g., a URL) and a different background are necessary to specify in ordering communication because this is easy to modify and it is very convenient in computerized communications to different parties.

g. Group VII: Claim 38:

This "system" claim contains analogous features as in a system claim 21 (analyzed above) whether an online ordering is from a customer or from a photographer, and whether a different selection of framed prints is made from said customer. The generic acts of viewing/ordering different frames for digital images are obvious to this computerized-application business although claim 38 has a phrase of "...order wood and metal frame prints" – this is obvious.

Therefore, similar rationales and references set forth for a rejection of claim 21 are applied for a rejection of claim 38 under 35 U.S.C. § 103(a) using Oberg, and Nozaki et al.

(13) NOTES: The examiner submits that a software for cropping image has been existed prior to this invention. That cropping task would be done before uploading a digital image (from using a user's computer software), or after uploading a digital image (from using a picture processing software).

A. The examiner submits that saying "Oberg's system can generate order copies, not prints to be framed" is incorrect (see page 3, para. 2); Oberg's system is capable to perform that task, a printer in Oberg's system would perform the same task as in claim 21. It is not inventive to have a system being able to generate a print (for framing) (this is old and well-known step even with Kodak's or Fuji's articles that the applicants submitted for consideration). This

above rationale would answer applicants' argument on page 4, para.1. It is true that Oberg's system does not expressly say the same claimed language as in the application; but this is an obvious rejection; Oberg's system is obvious in generating a prints (see Oberg, 4:41-50). In contrast to the argument on page 5, para. 1, the examiner submits that Oberg's system is able to use for ordering a frame (claiming that framing a picture wherein that picture is printed out from computer is not an inventive concept (see claim 21: "wherein the order servicing computer is configured to present the user with an opportunity to select a given type of frame for the print").

B. The argument on page 5, 3rd para. is about Oberg makes no mention of albums of "different" materials; the examiner submits that a selection from user would imply that there are different materials to choose (see Oberg, the abstract); the inventor does not necessarily spell-out similar languages because one with ordinary skill in the art would know and understand about the equivalent (although different) meanings of this invention.

C. For the argument on claim 31, the examiner submits that for identification/location purposes, those parameters (e.g., name, date, address etc.) mentions in the cited references are exemplary. One with ordinary skill in the art would recognize that an email message may include a service provider's URL; because an email would contain many different things (please note that those different things are non-functional descriptive material which are old and well-known), one of them can be a service provider's website because this

create a convenience for email receiver who likes to communicate with said service provider.

D. For the argument on claim 32, (page 6, para. 2), the examiner submits that the claimed language "background" is a non-functional descriptive material; moreover, this limitation is old and well-known in the art for this "system" claim, (see claim 32: The order servicing equipment defined in claim 21 wherein the order servicing computer is configured to provide the user with an opportunity to order a print of a digital image that includes the user as a subject and that includes a background different than the background against which the user was originally photographed). In other word, different background (e.g., a black background or a white background for a picture does not make it inventive).

E. For the argument on claim 33, (page 7, para. 2), the examiner submits that the claimed language "customer list" and "title" in a provider's database are old and well-known in the art. It is not inventive for a claimed system that having these features.

F. For the argument on claims 34 and 39, (page 7, para. 4), the examiner submits that the claimed apparatus is reasonably interpreted by physical structures that making up that apparatus; i.e. backgrounds, print, a digital image, Internet .etc. , (see claim 34: "The order servicing equipment as in claim 33 wherein at least one of the customers was originally photographed against a solid color background to produce a digital image and wherein that digital image was manipulated to replace the solid color background with a new background,

and wherein a print of the digital image that includes the customer with the new background is provided for on-line ordering by the customer over the Internet.

G. For the argument on claim 38, (page 7, para. 5 and page 8, para.1), the examiner submits that this claimed apparatus has old and well-known limitation as argued "Nothing in the Oberg, Weisman, or Nozaki references describes the ordering of wood or metal framed prints". Furthermore, the examiner picks "wood framed prints" because the applicants use the word "or", artisans would recognize that wood framed prints are old and well-known features.

H. The examiner considers claiming particular information are non-functional descriptive material; the claimed differences compared to cited prior art are only found in the non-functional data stored on the article of manufacturer in communications. Data identifying said "particular information" is not functionally related to the substrate of the article of manufacture or doing transferring/receiving actions. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gullack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

I. The claiming subject matter is only directed to viewing and ordering image-based products on the Internet (this subject matter is not an inventive concept at the time of the invention).

These limitations belong to a fundamental concept in doing retailed business of ordering processed images online. One skilled in the art can ascertain essential characteristics of cited references and, without departing

from their spirit and scope thereof, can make various modifications of these references to adapt its subject matter to various usages and conditions in film processing business. It would be obvious for one with ordinary skill in the art to implement Weisman or Nozaki et al. 's ideas with Oberg 's suggestion to perform specific functions as claimed, because components in this system claim must be distinguished from cited prior art in terms of structure(s) rather than functions.

J. Note: The independent claims 21, 33, 38 are directed to an "equipment"; therefore, this equipment/apparatus/system covers what that equipment/apparatus/system is, not what an equipment does.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

CUONG NGUYEN
PRIMARY EXAMINER

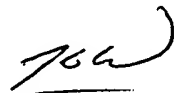


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June 10, 2004

An appeal conference was held on May 24, 2004 with:



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